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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,690	12/03/2001	Kenichi Otani	216009US3PCT	9480

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 09/926,690	Applicant(s) OTANI ET AL.	
	Examiner Donald Heckenberg	Art Unit 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on April 6, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on June 13, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicants filed an Information Disclosure Statement (IDS) on April 6, 2004. The IDS requests consideration of a Japanese Office Action included with the IDS. The Japanese Office Action has been considered, however no PTO-1449 form was provided with IDS for indication of consideration by the examiner.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Granberg (U.S. Pat. No. 4,014,739; previously of record).

Granberg discloses a pulp mold which comprises a molding part (18) of a prescribed shape. A peripheral part (including depression 18a) extends outward from a peripheral edge of the molding part (figure 2). A net (30 and 32) covers the molding part and at least part of the peripheral part (figure 2). A fixing member (16) is disposed on the periphery of the net, the fixing member being directly attached to the peripheral part to fix the net (using structure 42b).

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Granberg further disclose the fixing member to have a mating projection (42b) that fits in a mating depression made in the peripheral part to fix the fixing member to the peripheral part (see figure 2). The mating projection can be moved from a clamping position in which the net is forced against the shaping part (figure 2), to a non-clamping position (figure 3) in which the net is not forced against the shaping part, and thus, the apparatus of Granberg is provided with a means for adjusting a mold clamping force. Further, the movement to the non-clamping is the result of a force applied to member 42b which is not applied the net (see figures 2-3).

Claims 4-5 recite that the papermaking part is configured to face a second papermaking part. Written as such, these claims do not require a second papermaking part, but rather only require the first papermaking part be configured as such that it could be faced with a second papermaking part. The apparatus of Granberg, as shown in figure 1, is configured such that it is capable of being faced with another papermaking part, for example by placing a second mold upside-down on top of the first mold. Thus, Granberg anticipates the language of claims 4-5.

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4. Claims 6-10 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Randall (U.S. Pat. No. 2,600,265; previously of record).

Randall discloses a pulp molding die. The die comprises a molding part (17) of prescribed shape and a peripheral part (21) extending outward from the molding part. The die also comprises a flange (the element to which ring 33 is attached by stud 34, see col. 4, ll. 50-54), as well as a net (25) covering the molding part. The part of the net (29) which covers the peripheral part is positioned so that the flange prevents the net from receiving a clamping force from the stud (34) received by the flange (figure 1). Randall shows the part of the net which covers the peripheral part to be positioned lower than a surface that receives the mold clamping force a predetermined amount (figure 1). By using threaded studs (34) to provide the clamping force, Randall provides the apparatus with a means for adjusting the mold clamping force through by selecting how much the stud is tightened.

In the apparatus of Randall, element (33) acts as a sealing member by being positioned around the ends of the molding cavity (see figure 1). Element (33) that receives the clamping force exerted from the stud, and is provided on the part of the net covering the peripheral part (see figure 1).

5. Applicant's arguments filed April 6, 2004 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1-5, 11, and 13, Applicants assert that if element 42b of Granberg is equated to the fixing member as recited in claims 1 and 11, the fixing member of Granberg would not be directly attached to the peripheral part to fix the net during transition between Figures 2 and 3. Therefore, Applicants conclude that Granberg fails to teach or suggest a fixing member directly attached to the peripheral part to fix the net, such that the net is free from a force applied to the fixing member as defined in claims 1 and 11.

Claim 1 recites "said fixing member is directly attached to said peripheral part to fix said net, such that said net is free from a force applied to said fixing member." The force in this limitation is unspecified, that is, it is not described as a clamping force or force to hold the fixing part to the net. Therefore, this claim language does not require the recited force to cause the fixing member to act on the net. Any force that when applied to the fixing member does not act on the net anticipates this claim language. As set forth in the previous Office Action, and repeated above, Granberg's fixing part (16)

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is of this nature- it acts to fix the net as shown in figure 2, yet the force applied to fixing member to go from the position shown in figure 2 to the position shown in figure 3 does not act on the net.

With respect to the rejection of claims 6-10 and 14-17 as being anticipated by Randall, Applicants assert that the flange (as in explained in the Office Action) would not receive the mold clamping force recited in claims 6 and 14. Specifically, Applicants contend that the clamping force recited in claims 6 and 14 refers to a clamping force exerted on the upper surface of the flange that is not directly exerted on the nets when two molds are clamped together. Applicants thus conclude that Randall does not disclose or suggest two molds clamped together, and therefore fails to disclose or suggest a mold clamping force.

Applicants' argument necessitates the reading of a second mold structure into claims 6 and 14. However, it is noted that neither claim 6 nor claim 14 recites "a second mold."

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant case, Applicants' argument that a "a mold clamping force" necessitates a second

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mold is not persuasive. Claims 6 and 14 both refer to a papermaking mold and specify structures that the mold comprises, including a papermaking part which functions as the molding surface. The clamping force recited in the claim acts on this papermaking part, and is therefore "a mold clamping force." Thus, claims 6 and 14 describe a complete mold structure without the necessity of a second mold. Moreover, Applicants' reference to a line in the specification (p. 9, ll. 9-11) where it is described how the clamping force acts when a second mold does not suffice to show that clamping force is defined in a manner as requiring a second mold. Although "it is entirely proper to use the specification to interpret what...is meant by a word or phrase in the claim,...this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By 'extraneous' [it is meant] a limitation read into a claim from the specification wholly apart from any need to interpret particular words or phrases in the claim." In re Paulsen, 30 F.3d 1475, 1480, 21 USPQ2d 1671, 1674 (Fed. Cir. 1994) (citation omitted). To require a second mold for there to be a "mold clamping force" would be to add an extraneous limitation to the claims. Applicants therefore cannot assert that Randall fails to anticipate a mold clamping force by not disclosing a second mold.

6. Claim 18 is allowed. See the reasons for indicating allowable subject matter in the previous Office Actions.

7. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See the reasons for indicating allowable subject matter in the previous Office Actions.

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

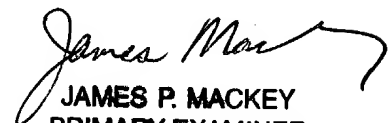
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).


Donald Heckenberg
June 17, 2004


JAMES P. MACKEY
PRIMARY EXAMINER
6/23/04